



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,058	09/19/2003	Stefan J. Rublowsky	PRKR-4500	7284

7590 03/09/2005

Philip A. Girard
GIRARD & EQUITZ LLP
Suite 1110
400 Montgomery Street
San Francisco, CA 94104

EXAMINER	
LONEY, DONALD J	
ART UNIT	PAPER NUMBER

1772

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,058

Applicant(s)

RUBLOWSKY ET AL.

Examiner

Donald Loney

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1,3,5,11,13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-10,12,14,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II in the reply filed on February 17, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2,4,6,7,8,18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Giulie (4471976).

Giulie teaches a binder strip 12 containing a substrate 19,23 that has a heat activated adhesive 14 thereon. The adhesive has what can be considered grooves where valleys 17 are formed therein (i.e. the section between peaks 16). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. Refer to figures 1, 3 and 4 along with column 2, lines 27-42.

4. Claims 2,4,6,7,8,9,12,14,18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by DuCorday (4800110).

DuCorday also teaches a strip 10 containing a substrate with a heat activated adhesive 26 thereon that contains grooves 34,36. The grooves appear, from the figures,

to be more than 20% the thickness of the adhesive. This rejection is being made to specifically address the limitation that the grooves run the length of the strip. The grooves run parallel to the longitudinal axis of intermediate spine section 16. The applicant, due to the use of the open claim language to 'comprising', is not excluding any other section of the strip. It can be seen from applicants' figures 4 and 6a-6C that the prior arts adhesive runs the same direction along the binding.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giulie or DuCorday in view of Pogrzeba et al (4247273).

The primary references teach the invention substantially as recited except for the deformities to be punctures. Refer to the 35 USC 102 rejections above. The applicant discusses the punctures, on page 11 of the specification, as being formed using an awl, which would form an indent in the adhesive.

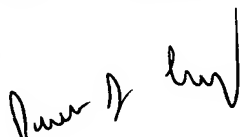
Pogrzeba et al teaches that either grooves or indents (punctures as described above) can be formed in a layer in order to prevent a "winged effect" (i.e. curling). This deforming leads to a greater stability in shape of the layer. This is the same reason the applicant is deforming the adhesive layer (i.e. to reduce curl). Refer to figures 3a and 3b along with column 2, lines 41-52.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to form the deformities of a puncture shape, as taught by Pogrzebra et al, in order to provide greater stability to the layer by preventing curl of the layer motivated by the fact Pogrzebra et al teaches that either grooves or punctures can provide greater stability to the layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
03/06/2005